

REMARKS

Applicants submit this Amendment in reply to the Office Action mailed April 22, 2009 ("Office Action"). Claims 1-4, 6-7, 9-19, 21-22, 24-34, 36-37, and 39-45 are currently pending in this Application, of which claims 1, 16, and 31 are independent. Applicants have amended independent claims 1, 9, 16, 31, and 39, and have canceled claims 8, 23, 38 without prejudice or disclaimer. These amendments find support throughout the specification.

In the Office Action, the Examiner took the following actions:

- (1) rejected claims 1-8, 12-23, 27-38, and 42-45 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,901,214 ("*Shaffer*"); and
- (2) objected to claims 9-11, 24-26, and 29-41 as being dependent upon a rejected base claim, but indicated the claims would be allowable if rewritten in independent form including all limitations of the base claim and any intervening claims.

Applicants thank the Examiner for indicating that claims 9-11, 24-26, and 29-41 would be allowable if rewritten in independent form.

Applicants respectfully traverse all pending rejections, as follows:

I. Rejections Under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 1-8, 12-23, 27-38, and 42-45 under 35 U.S.C. § 103(a) as being unpatentable over *Shaffer*. A *prima facie* case of obviousness has not been established.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections

on obviousness cannot be sustained with mere conclusory statements.” M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01(III) (emphasis in original). “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. M.P.E.P. § 2141.02(I) (emphases in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Here, a *prima facie* case of obviousness has not been established because the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Examiner has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

A. *Shaffer* does not teach “the calculating further includes converting at least one digit of numeric data into different numeric data.”

Amended independent claim 31 now recites “the calculating further includes converting at least one digit of numeric data into different numeric data.” *Shaffer* does not teach or suggest these features, nor would its teachings render them obvious to one of ordinary skill in the art.

Shaffer discloses a “one number intelligent call processing system” that, as part of automating consumer telephone calls, attempts to precisely identify a caller’s location. Title; 1:55-2:22. In more detail, *Shaffer* discloses creating a “spatial key,” which is “a standardized precise and universal database linkage key that can be assigned to all the United States telephone numbers and [several national] databases.” 4:31-53. As *Shaffer* explains, this spatial key may be generated using several “candidates,” including two of which the Examiner points to as relevant teachings to the Applicants’ claims: a telephone number and a USPS Zip Code.

But *Shaffer* merely appends existing numbers to these “candidate” identifiers. For example, *Shaffer* teaches creating an “extended Zip 19-digit code” beginning with a standard Delivery Point Code(i.e., a ZIP+6 code having 11 digits). See *Schaffer*, col. 11, ll. 40-45. It then retrieves a “secondary address” from the USPS Address Management system (i.e., an additional code having 8 digits), and appends the secondary address to the end of the standard Delivery Point Code, thereby creating the extended 19-digit ZIP Code. See *id.*

Applicants respectfully submit that appending a secondary address to a standard Delivery Point Code does not fairly equate to “converting at least one digit of numeric

data into different numeric data,” as claimed. Instead, *Shaffer* teaches appending the same numeric data, without any conversion.

Consequently, *Shaffer* does not disclose, teach, or suggest “converting at least one digit of numeric data into different numeric data,” as recited in amended claim 31.

B. *Shaffer* does not teach “creating the alternative delivery point code . . . , wherein the creating comprises calculating, based on the secondary element, a random number or a pseudo-random number and setting at least one digit of the alternative delivery point code to the calculated number, wherein the calculating further includes converting alphanumeric data to numeric data.”

Amended independent claims 1 and 16 now recite “creating the alternative delivery point code . . . , wherein the creating comprises calculating, based on the secondary element, a random number or a pseudo-random number and setting at least one digit of the alternative delivery point code to the calculated number, wherein the calculating further includes converting alphanumeric data to numeric data.” *Shaffer* does not teach or suggest these features, nor would its teachings render them obvious to one of ordinary skill in the art.

First, *Shaffer* does not teach or suggest “converting alphanumeric data [(such as “3A”)] to numeric data,” as claimed. Instead, *Shaffer* specifically teaches an opposite approach of keeping alphabetical data when appending to the end of a Delivery Point Code. *Shaffer*’s opposite approach is clearly explained in the same passage the Examiner cited for the subject matter of previous claims 8, 23, and 38 (now canceled). The cited passage is replicated below:

“If the range is not a straight numeric, such as 3A to 3N, then secondary addresses 3A, 3B, . . . 3N are generated. In most situations where the secondary address is complex, such as 3B ½, the range or span on the ZIP+4 file is 3B ½ to 3B ½.”

Shaffer, col. 49, ll. 15-19.

Because *Shaffer* specifically teaches maintaining the alphabetic portion of the data, it does not disclose, teach, or suggest “converting alphanumeric data to numeric data,” as claimed.

Second, the portions of *Shaffer* the Examiner relies on for “calculation” do not actually discuss performing a calculation to create a Delivery Point Code, as claimed in amended claims 1, 16, and 31. Rather, as previously discussed, *Shaffer* merely discloses appending digits to a standard Delivery Point Code to create an Extended Zip 19-digit Code capable of identifying a caller’s unique housing or business unit within a multiple unit building or firm. See *Shaffer*, col. 11, ll. 26-56. In more detail, *Shaffer* creates this “extended Zip 19-digit code” beginning with a standard Delivery Point Code(i.e., a ZIP+6 code having 11 digits). See *Shaffer*, col. 11, ll. 40-45. It then retrieves a “secondary address” from the USPS Address Management system (i.e., an additional code having 8 digits), and appends the secondary address to the end of the standard Delivery Point Code, thereby creating the extended 19-digit ZIP Code. See *id.* Applicants respectfully submit that contrary to the Examiner’s assertion, this appending a secondary address to a standard Delivery Point Code does not fairly equate to performing any “calculating.”

The Examiner cites a portion of *Shaffer* that states “[u]sually over time, the line numbers associated with a [telephone number prefix] become randomly distributed across the locations . . . of the households and businesses” *Shaffer*, col. 7, ll. 40-43. This reference to “random,” however, merely identifies a “deficiency” of using a telephone number to generate the spatial key of *Shaffer’s* invention. See *Shaffer*, col.

7, ll. 45-55. *Shaffer* nowhere teaches or suggests, explicitly or inherently, any need or desire to “creat[e] [a] delivery point code [by] calculating . . . one of a random number or a pseudo-random number,” as recited in claim 1.

Furthermore, at least because this disclosure relates to telephone numbers, rather than Delivery Point Codes, it also does not teach or suggest “setting at least one digit of the alternative delivery point code to the calculated number,” as also recited in claim 1.

C. No *prima facie* case of obviousness

In view of at least these mischaracterizations of *Shaffer*, the Examiner has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention as recited by amended independent claims 1, 16, and 31. Thus, the Examiner has failed to clearly articulate a reason why these claims would have been obvious to one of ordinary skill in the art in view of the prior art. Accordingly, a *prima facie* case of obviousness has not been established with respect to independent claims 1, 16, and 31, and the rejection under 35 U.S.C. § 103(a) must be withdrawn. For the same reasons, claims 2-4, 6-7, 9-15, 17-19, 21-22, 24-30, 32-34, 36-37, and 39-45 are also allowable at least due to their dependence from independent claims 1, 16, and 31.

II. Objections to Claims 9-11, 24-26, and 29-41 as Being Dependent on a Rejected Base Claim

For the reasons described above, the Office has not established a *prima facie* case of obviousness for independent claims 1, 16, and 31. Accordingly, none of claims dependent claims 9-11, 24-26, 29-30, 32-35, and 36-41 depends on a properly rejected base claim.

Conclusion¹

In view of the foregoing remarks, Applicants submit that the pending claims, as amended, are neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request that the Examiner reconsider and withdraw the rejections and objections to the pending claims and pass this application to issue.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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¹ It is to be understood that Applicants are in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification or abstract and or shown in the drawings. Rather, Applicants believe that they are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.